

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 1, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

A. H. Robins Company, Incorporated

v.

Ronald Striegel

---

Opposition No. 101,325  
to application Serial No. 74/686,165  
filed on June 9, 1995

---

Steven J. Baron of American Home Products Corporation for A.  
H. Robins Company, Incorporated.

Sandeep Seth of Seth Intellectual Property Law Offices for  
Ronald Striegel.

---

Before Seeherman, Quinn and Hohein, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

A. H. Robins Company, Incorporated has opposed the  
application of Ronald Striegel to register EXPECTAB as a  
trademark for "pharmaceutical preparations, namely

**Opposition No. 101,325**

guaifenesin based expectorants."<sup>1</sup> As grounds for opposition, opposer has alleged that it is a manufacturer and distributor of over-the-counter healthcare products and prescription medicines; that in 1954 it began to use EXTENTABS as a trademark for oral pharmaceutical preparations, such as cough and cold products; that opposer owns a registration for the mark EXTENTABS; and that applicant's use of the mark EXPECTAB for the goods identified in his application is likely to cause confusion and mistake and to deceive.

Applicant has denied the salient allegations of the notice of opposition and, in addition to detailing its reasons why confusion is not likely, has asserted that opposer's mark is not used to identify a product, but is used on multiple products to describe or indicate a characteristic of the product.

The record includes the pleadings; the file of the opposed application; and the testimony, with exhibits, of opposer's witnesses Cindy Berk and Robert Czenszak. Opposer has also made of record, under a notice of reliance, status and title copies of opposer's registrations for the marks EXTENTABS for extended action medicinal preparation providing for the gradual release of a medicament in the

---

<sup>1</sup> Application Serial No. 74/686,165, filed June 9, 1995, asserting a bona fide intention to use the mark in commerce.

**Opposition No. 101,325**

gastro-intestinal tract;<sup>2</sup> DONNATAL EXTENTABS for extended action medicinal preparation in the treatment of gastro-intestinal disturbances;<sup>3</sup> DIMETAPP EXTENTABS for extended action antihistamine medicinal preparation;<sup>4</sup> and QUINIDEX EXTENTABS for antiarrythmic medicinal preparation for use in cardiac therapy.<sup>5</sup> Applicant did not submit any evidence.

The case has been fully briefed; an oral hearing was not requested.

There are some preliminary matters to be discussed. First, although opposer did not plead ownership of its registrations for, and use of, the marks DONNATAL EXTENTABS, DIMETAPP EXTENTABS and QUINIDEX EXTENTABS, they were made of record and were discussed extensively during the testimony of opposer's witnesses. Accordingly, we deem the pleadings to be amended to include those marks.

Second, to the extent that applicant has asserted as an affirmative defense that opposer's EXTENTABS marks are merely descriptive, such an attack cannot be made in the absence of a counterclaim for cancellation of the registrations. However, because all of the registrations

---

<sup>2</sup> Registration No. 604,409, issued April 12, 1955; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.

<sup>3</sup> Registration No. 768,358, issued April 21, 1964; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

<sup>4</sup> Registration No. 769,055, issued May 5, 1964; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

<sup>5</sup> Registration No. 773,526, issued July 21, 1964; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

are more than five years old, they cannot be cancelled on the ground of mere descriptiveness.

Third, in its brief applicant appears to challenge opposer's claim of priority and its right to rely on the uses to which its witnesses testified. This claim is apparently based on the fact that opposer's witnesses are not employees of opposer.

It is true that the witnesses never testified as to their respective companies' connection with the opposer, A. H. Robins Company, Incorporated. Mr. Czenszak testified that he is employed by Wyeth-Ayerst Laboratories, a subsidiary of American Home Products Corporation, while Ms. Berk stated that she works for Whitehall Laboratories, a division of American Home Products Corporation. In the notice of reliance with which opposer listed the witnesses' testimony depositions,<sup>6</sup> opposer identifies the companies for which the witnesses work, indicating that Wyeth-Ayerst Laboratories and Whitehall-Robins, Inc. are wholly owned subsidiaries of American Home Products Corporation, which is the parent company of opposer. Although such a statement in a notice of reliance would normally be insufficient to establish the corporate relationship, in this case applicant

---

<sup>6</sup> It should be noted that testimony depositions do not need to be submitted under a notice of reliance; they are part of the record pursuant to Trademark Rule 2.123.

has treated it as factual, and we therefore deem it to be stipulated into the record.

Applicant's claim that opposer has not shown priority is not well taken. Opposer's subsisting registrations, showing ownership in opposer, are of record. Therefore priority is not in issue. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).<sup>7</sup>

Applicant also asserts that opposer cannot rely on the witnesses' testimony to show use of the registered marks. It is true that opposer cannot rely on use of the marks by Wyeth-Ayerst and Whitehall in the manner that a licensor can rely on use made by its licensee. However, it is evident from the testimony, during which the registrations owned by opposer were introduced, that the sales and promotion of the various trademarked products about which the witnesses testified referred to the marks owned by opposer. Further, the packaging for products bearing the marks DIMETAPP EXTENTABS, DONNETAL EXTENTABS and QUINIDEX EXTENTABS, which were submitted as exhibits with the witnesses' testimony, bear opposer's name, A H ROBINS. Thus, even though opposer

---

<sup>7</sup> We note that opposer has devoted a significant part of its brief to show that opposer could establish priority under the test set forth in **Towers v. Advent Software Inc.**, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990). However, since opposer is relying on its registered marks, there was no need for it to submit argument that its marks have acquired distinctiveness as trademarks.

cannot rely on Wyeth-Ayerst's and Whitehall's use in the sense of a licensee whose use inures to the benefit of the licensor, it can rely on their sales and promotion in the same manner that a manufacturer can use the product sales and promotion by an unrelated retail store which sells its product. See **Somerset Distilling, Inc., v. Speymalt Whisky Distributors Ltd.**, 14 USPQ2d 1539 (TTAB 1989).<sup>8</sup>

Mr. Czenszak testified about the marks QUINIDEX EXTENTABS and DONNETAL EXTENTABS. The literature submitted with Mr. Czenszak's testimony indicates that QUINIDEX EXTENTABS is used by opposer as a trademark for quinidine sulfate extended-release tablets, a prescription antiarrhythmic drug. This product has been promoted since 1962, and listings for it appear in a number of medical or drug reference books, including the Physician's Desk Reference, which is found in every doctor's office, pharmacy and hospital.

Wyeth-Ayerst promotes the QUINIDEX EXTENTABS product at medical conventions held by organizations such as the American Heart Association, and at pharmacy meetings or hospital settings. It has also published advertisements in

---

<sup>8</sup> Applicant does not seem to argue that the use by Wyeth-Ayerst and Whitehall is an adverse use, such that opposer has abandoned its mark by permitting such use. Such an assertion would, in any event, be unavailing in the absence of a counterclaim for cancellation of the subject registrations.

**Opposition No. 101,325**

journals directed to physicians, pharmacists and health care professionals. Wyeth-Ayerst produces a number of sales aids for its representatives, including cards of various sizes which are left with physicians and in hospitals. In addition, Wyeth-Ayerst provides telephone message pads for physicians, each page of which bears an advertisement for QUINIDEX EXTENTABS tablets, and patient information "tear pads," which are information sheets which physicians can give to their patients to educate them about various heart problems and the QUINIDEX EXTENTABS product.

The QUINIDEX EXTENTABS are sold to such customers as doctors, drug stores, hospitals, nursing homes, and chain stores. Although the sales figures have been submitted under seal, we can state that since 1992 they have amounted to many millions of dollars.

Wyeth-Ayerst also markets a drug under the mark DONNATAL EXTENTABS. The product literature indicates that it is for use in the treatment of irritable bowel syndrome and duodenal ulcer. As with the QUINIDEX EXTENTABS drug, the classes of customers include doctors, drug stores, physician and dental supply, hospitals, chain stores and nursing homes. Again, opposer has filed the sales figures for this product under seal, but since 1992 annual sales have been substantially in excess of a million dollars.

**Opposition No. 101,325**

Ms. Berk testified as to Whitehall Laboratories' activities regarding the mark DIMETAPP EXTENTABS. This mark is used on an over-the-counter product for cold and allergy relief. It is sold in food and drug stores, in mass merchandisers, and through HMO's. It is sold to hospitals, and Whitehall also provides physicians with sample products to give to patients.

Wyeth-Ayerst advertises DIMETAPP EXTENTABS products through national television and radio commercials; "free-standing inserts" (the coupon section of Sunday newspapers); floor stands in stores, near the shelved product; co-op advertising, such as coupons and circulars, with stores such as CVS; ads in physician trade journals; displays at physicians' conventions; and tear sheets distributed to patients by physicians. Information about promotion expenditures has been marked confidential, but annual expenditures are in the millions. Sales information is also confidential, but such figures are also in the millions.

No information has been submitted with respect to applicant, or the product on which he intends to use the applied-for mark.

As noted previously, priority is not in issue. Thus, we turn to a consideration of whether opposer has proven a likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are

**Opposition No. 101,325**

relevant to the factors bearing on this issue, as set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Although opposer, in its brief, refers to its EXTENTABS brands, in fact opposer's marks are, on the one hand, EXTENTABS per se, and on the other, QUINIDEX EXTENTABS, DONNATAL EXTENTABS and DIMETAPP EXTENTABS. In the latter group, as shown by the exhibits of record, the term EXTENTABS has a subsidiary function to indicate that the medication identified by the primary term—QUINIDEX, DONNATAL and DIMETAPP—is furnished in a time-release form. Because of this, the initial term in each of these marks is the dominant element thereof. When these marks of opposer and applicant's mark are considered as a whole, their appearance, pronunciation, connotation and commercial impression differ so greatly that we find no likelihood of confusion. This du Pont factor of the differences in the marks so outweighs any other factors which favor opposer that it is dispositive in this case. See **Kellogg Company v. Pack-em Enterprises, Inc.**, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

This brings us to the question of likelihood of confusion between opposer's mark EXTENTABS per se, registered for "extended action medicinal preparation providing for the gradual release of a medicament in the

gastro-intestinal tract" and applicant's mark EXPECTABS for "pharmaceutical preparations, namely guaifenesin based expectorants." The identification in opposer's registration is not limited as to the type of medicinal preparation on which the mark may be used. Thus, we must consider it to be used for all medicinal preparations, including cold and cough relief medicines, which would encompass the expectorants identified in applicant's application. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be). These goods would be sold in the same channels of trade, for example, in drug and food stores, and mass merchandisers. In this connection, opposer has shown that its cold and allergy relief product bearing the trademark DIMETAPP EXTENTABS is sold in such channels of trade.

Further, the goods, based on the respective identifications, would include over-the-counter medications which would be purchased by the general public. Over-the-counter cold and cough relief medications are likely to be

shelved and displayed together, or in close proximity to each other.

With respect to the marks, there are strong similarities in appearance and pronunciation in that both begin and end with the same letter strings and syllables, while the differences are not as apparent because they are in the middle, three-letter syllable (and even in that syllable, the middle letter is the same). We recognize that the connotations of the mark differ: EXTENTABS, used for an extended action medicinal preparation, suggests that they are extended action tablets, while EXPECTABS for expectorants suggests that they are tablets which act as expectorants. In this connection, we consider opposer's statement that "it stretches credulity to the breaking point to assume that users or professionals coming into contact with the EXTENTABS mark ascribe any meaning to it," brief, p. 6, to itself be hardly credible.

Nonetheless, we find that the similarities in appearance and pronunciation are sufficient that, when used in connection with identical or closely related goods, confusion is likely to occur. It must be remembered that those suffering from colds, seeking to purchase cold or cough relief products, are not necessarily going to be alert to distinctions in connotations of marks, or to engage in a detailed analysis of them.

We also point out that there is no evidence of third-party use or registrations for marks similar to EXTENTABS and EXPECTABS.

It has often been stated that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant.

**W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.**, 190 USPQ 308 (TTAB 1976). In a case involving pharmaceutical products, where the consequences of confusion can have disastrous results, there is an even stronger reason for resolving doubt in this manner.

Accordingly, we find that applicant's use of the mark EXPECTABS for pharmaceutical preparations, namely guaifenesin based expectorants, is likely to cause confusion with opposer's mark EXTENTABS, registered for extended action medicinal preparation providing for the gradual release of a medicament in the gastro-intestinal tract.

In making our decision herein, we have given no weight to opposer's arguments regarding the fame of the mark EXTENTABS. Although opposer has shown significant sales and advertising of its DIMETAPP EXTENTABS product, no such evidence has been submitted for EXTENTABS per se. In fact, opposer has not shown any use at all of EXTENTABS by itself.

**Opposition No. 101,325**

Further, because of the manner in which the mark DIMETAPP EXTENTABS has been used and promoted, it is, as we stated previously, the term DIMETAPP which enjoys the primary recognition, and the evidence of record does not persuade us that this same recognition would apply to EXTENTABS.

Decision: The opposition is sustained on the basis of opposer's registration for the mark EXTENTABS per se.

E. J. Seeherman

T. J. Quinn

G. D. Hohein  
Administrative Trademark Judges  
Trademark Trial and Appeal Board